

REMARKS

Reconsideration is respectfully requested. Claims 1, 4, 6, 9 and 18, 19 and 21-24 are pending. Claims 2-3, 5, 7-8, 10-17 and 20 are canceled. Claims 1, 6 and 23 are amended. Cancellation and amendment of the claims does not affect inventorship.

Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Claim Amendments

Claims 1, 6 and 23 are amended for technical clarity.

Objections to the Specification

The Examiner objects to the Specification and states that "it is unclear why Figure 3 representing the coordinates of instant ISP protein crystal has amino acid sequence of 16-314 of SEQ ID NO:1, which is truncated form.

Amino acid residue 1-15 of SEQ ID NO:1 represent the N-terminal His-tag- see residues 1-15, underlined in Fig. 1, SEQ ID NO:1. Thus, Figure 3 depicts a set of atomic structure coordinates for the IspA portion of SEQ ID NO:1 as derived by X-ray crystallography from a crystal that comprises the protein. In light of the foregoing arguments, the Examiner is requested to withdraw the objections to the Specification.

Claim Rejection Under 35 U.S.C. § 112

Written Description and Enablement

Claims 1, 4, 6, 9, 10, 18 and 20-23 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description and enablement requirement. Applicants respectfully traverse.

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he

or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). **The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.** See M.P.E.P. § 2163.02 (emphasis added).

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498.

Claims 10 and 20 have been canceled, thereby rendering the rejections with respect to these claim moot. Claims 1 and 6 have been amended to clarify their scope. Support for this amendment can be found, for example, in paragraphs [0115] to [0125].

In view of the foregoing amendments and arguments, Applicants respectfully request the Examiner to withdraw the instant rejection of claims.

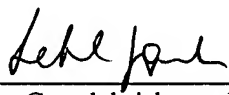
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CONCLUSION

In view of the foregoing amendments and arguments, it is believed that all claims now pending in this application are in condition for allowance. Should the Examiner not agree, the Applicant respectfully asks the Examiner to contact the undersigned at the phone number below to discuss any remaining issues and accelerate the examination and allowance of this application. Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (Client Matter No. 067450-5011US).

Respectfully submitted,

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